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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,031	01/22/2001	Donald Edward Johnson	2930.1000-001	3319
21005	7590	11/18/2004	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			FULTS, RICHARD C	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	JOHNSON ET AL.
09/767,031	
Examiner	Art Unit
Richard Fults	3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 22 January 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

DETAILED ACTION

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-40 are rejected under 35 USC 101 as the claimed invention is directed to non-statutory subject matter. For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides **a limitation in the technological arts** that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section IV 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

The invention **in the body of the claim must recite technology**. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3628

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,021,397A).

Jones discloses (see at least columns 1-24, but in particular col. 10, lines 18-53) the steps, methods, and systems of claims 1-40, including compiling donor investment portfolio data from each brokerage account associated with the donor investment portfolio, calculate and display unrealized gain of each asset in the donor portfolio, calculate and display estimated tax savings achievable by transferring each asset in the donor investment portfolio to the receiving entity, selecting specific assets from the donor investment portfolio for transferring to the receiving entity, selecting an asset to transfer to the receiving entity, selecting an asset transfer timing technique, initiating a transfer of the asset to the receiving entity according to the selected asset transfer technique, recording an exact price of the asset at the time the asset is transferred to the receiving entity, compiling donor investment portfolio data, identifying a proxy organization having a relationship to the receiving entity allowing the proxy organization to receive an asset transfer on behalf of the receiving entity receiving the asset transfer from the donor to the proxy organization, transferring either the asset or the cash proceeds from the sale of the asset from the proxy organization to the receiving entity, and establishing a donor account with the donor advised organization. Jones does not discuss a proxy organization or the donation of an appreciated asset.

The applicant on pages 2-10 of the specifications describes the old and well known practice of donors making charitable donations of appreciated assets, primarily securities from a brokerage account. It is inherent in the donation of appreciated assets that the donation is being made for tax purposes and it is also inherent that therefore all

of the mechanical details of tax considerations consisting of the steps of compiling, calculating, displaying, selecting, recording, initiating, identifying, transferring, etc., the exact details of the security or its sale proceeds to be donated will have been performed in order to facilitate that donation for tax considerations, including the details of the liquidation of the asset. In addition the same specifications disclose the prior existence of proxy organizations that facilitate those donations (DAOs), together with examples of how they operate. As to claim 32, the use of an employee benefits system for facilitating employee donations to a charity are old and well known, whether it be a direct payroll receivable to the employee or a bonus to be redirected. As to claim 36, the source of the security interest is not material to the donation concept and methods of transfer. As to claim 38, a donation is a donation, whether it is directly from the pocket of the donor or if it is an asset of the donor redirected by specific instruction of the donor, either directly or through a proxy organization. In addition, for many years prior to this application all of the steps described herein were performed manually, and consequently claims regarding automation of those steps are simply automation of a known manual process, which is not patentable. Because it would have been commonsense and advantageous it would have been obvious to one skilled in the art at the time of the invention to have been aware of all of these facts to implement this invention prior to its filing.

3. Note is taken by the examiner that should the applicant find objectionable any statements made herein by the examiner regarding obviousness applicant can make a proper challenge to those statements only by providing adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying those statements: a simple response requesting a reference without doing so, or a response that fails to logically refute the basic assumptions underlying the justification, will result in an improper and failed challenge and those unchallenged statements will remain the record of the case. Applicants must seasonably challenge those statements in the first response following an Office Action. If an applicant fails to do so, his right to challenge them is waived.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



RCF

11/9/2004



FRANK Z. POINVIL  
PRIMARY EXAMINER

Art 3628